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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,902	01/28/2002	Shinichi Koyama	03500.016144	2051
5514	7590	01/26/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			VIEAUX, GARY	
			ART UNIT	PAPER NUMBER
			2612	
DATE MAILED: 01/26/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/055,902

Applicant(s)

KOYAMA, SHINICHI

Examiner

Gary C. Vieaux

Art Unit

2612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 10, 2005 has been entered.

### ***Amendment***

In response to the Office Action dated July 28, 2005, the Title, the Specification and claims 1, 2, 4-7, and 9-12 have been amended.

### ***Response to Amendment***

In response to Applicant's amended Title, the Examiner finds the Title to be more clearly indicative of the invention to which the claims are directed, and therefore, the objection to the Title is withdrawn.

In response to Applicant's amended Specification, the Examiner finds the amendment directly addresses inconsistencies in spelling and grammar, and therefore, the outstanding objection to the Specification is hereby withdrawn.

***Response to Arguments***

Applicant's arguments with respect to the 35 U.S.C. 103(a) rejections as being unpatentable over Saito et al. (US 6,184,922) in view of Greening et al. (US 5,701,912) have been fully considered but they are not persuasive.

5        Regarding amended claim 1, Applicant submits that the recording unit is not capable of separating from the image capture apparatus, as currently amended. However, support for this limitation was not found within the original disclosure and is therefore moot (please see the 35 USC § 112 rejection supra.)

10       Applicant also submits that neither the Saito nor the Greening reference teach starting of output in response to the instruction of starting recording so that an external storage device can start recording the image and sound data and stopping outputting to the external storage device in response to the instruction of stopping recording so that the external storage device can stop recording. The Examiner respectfully disagrees.

15       Saito provides a teaching outputting of image data that is to be recorded on the recording medium in response to an instruction of starting recording, and stopping output of image data that is to be recorded in response to an instruction of a stopping recording (by way of the release switch 48, Abstract and col. 12 lines 25-32.)

Based on the foregoing response, the Examiner respectfully maintains the 35 U.S.C. § 103(a) rejections to claim 1.

20       Regarding claim 5, although the wording is different, the material is considered substantively equivalent to claim 1, as discussed above, and therefore the Examiner

relies on the same conclusions to amended claim 5, as it is currently written, and respectfully maintains the 103(a) rejection to claim 5.

Regarding claims 2-4 and 6-12, each depend either directly from or indirectly from independent claims 1 or 5, respectively, and thus inherit all the limitations of independent claims 1 or 5. Consequently, based on their dependence and the foregoing response to arguments relating to claims 1 and 5, the Examiner respectfully maintains the 35 U.S.C. § 103(a) rejections to claims 2-4 and 6-12.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 1-12** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 1 and 5, and through dependency claims 2-4 and 6-12, include the amended limitation regarding wherein said/the "recording unit is not capable of separating from said image capture apparatus" (Amendment p. 6, line 10 of claim 1, p. 7 lines 7-8 of claim 5.) After review of the Specification, support for this limitation was not found to be included in the application as filed.

For the purposes of claim examination, claims 1 and 5 will be examined on their merits without consideration given to this limitation until such support is demonstrated.

***Claim Rejections - 35 USC § 102***

5           The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

10           (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15           **Claims 1-2, 4-6, and 8-12** are rejected under 35 U.S.C. 102(e) as being anticipated by Aizawa (US 6,832,275.)

          The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

25           Regarding claim 1, Aizawa discloses a similar image capture apparatus that can both record image and sound data on a recording medium and in an external storage device in response to capture control instructions (fig. 3, col. 6 line 7 – col. 7 line 34.)

Regarding claim 2, Aizawa discloses all the limitations of claim 2 (see the 102(e) rejection to claim 1 supra) including disclosing output of image and sound data irrespective of whether or not the recording unit can normally record the image and sound data on the recording medium (col. 6 line 7 – col. 7 line 34.)

5        Regarding claim 4, Aizawa discloses all the limitations of claim 4 (see the 102(e) rejection to claim 1 supra) including disclosing wherein the image capture apparatus is a camera-integrated digital video recorder (fig.1, col. 5 lines 4-16.)

Regarding claim 9, Aizawa discloses all the limitations of claim 9 (see the 102(e) rejection to claim 1 supra) including disclosing the image capture apparatus further  
10    comprising an image data generating unit adapted to capture an image and generate the image data that is to be recorded on the recording medium (col. 5 lines 4-16), and a sound data generating unit adapted to collect a sound and generate the sound data that is to be recorded on the recording medium (col. 5 lines 57-63.)

Regarding claim 10, Aizawa discloses all the limitations of claim 10 (see the  
15    102(e) rejection to claim 2 supra) including disclosing the image capture apparatus further comprising an image data generating unit adapted to capture an image and generate the image data that is to be recorded on the recording medium (col. 5 lines 4-16), and a sound data generating unit adapted to collect a sound and generate the sound data that is to be recorded on the recording medium (col. 5 lines 57-63.)

20        Regarding claims 5, 6, 8, and 11-12, although the wording is different, the material is considered substantively equivalent to claims 1-2, 4, and 9-10, respectively, as discussed above.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

5 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10 **Claims 1-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito et al. (US 6,184,922) in view of Greening et al. (US 5,701,912.)

Regarding claim 1, Saito provides a teaching of a recording unit adapted to record on a recording medium (fig. 1 indicator 97), as well as a communication unit (fig. 1 indicator 6) capable of connecting with an external storage device (fig. 1 indicator 10) and outputting the data that is to be recorded on the recording medium (fig. 1, in which data is output from indicator 6 to both indicators 10 and 97.) Saito also provides a teaching wherein said image capture apparatus (fig. 1 indicator 3) is capable of controlling the start of an output of the image data that is to be recorded on the recording medium in response to an instruction of starting recording, and to stop an output of the image data that is to be recorded in response to an instruction of a stopping recording (by way of the release switch 48, Abstract and col. 12 lines 25-32.) However, Saito is not found to include sound data.

Nevertheless, Greening, which deals with matters similar to Saito, is provided to teach the inclusion of microphones within endoscopes (col. 3 line 63 – col. 4 line 7.) It would have been obvious to one of ordinary skill in the art at the time of the invention to include sound data as taught by Greening, with the image capture apparatus as taught



by Saito and being operated on in a similar manner to that of the image data as taught by Saito. One of ordinary skill in the art at the time of the invention would have been motivated to include sound data with the image data of an endoscope in order to simulate both eyes and ears inside of a body cavity.

5           Regarding claim 2, Saito and Greening teach all the limitations of claim 2 (see the 103(a) rejection to claim 1 supra) except for explicitly teaching an image capture apparatus wherein the image capture apparatus is capable of controlling said communication unit to continue an output of the image and sound data that is to be recorded on the recording medium until the instruction stopping recording is inputted,  
10   irrespective of whether or not said recording unit can normally record the image and sound data on the recording medium.

          Nevertheless, it would have been obvious to one of ordinary skill in the art at the time of the invention for the communication unit to continue to output the image and sound data that is to be recorded on the recording medium until the instruction stopping  
15   recording is inputted, irrespective of whether or not said recording unit can normally record the image and sound data on the recording medium, so that the image and sound data outputted may still be observed by a viewing monitor (e.g., fig. 1 indicator 7.) It is further noted that the image data outputted to the monitor is the same image and sound data that would be recorded.

20           Regarding claim 3, Saito and Greening teach all the limitations of claim 3 (see the 103(a) rejection to claim 1 supra) including teaching an apparatus wherein said

communication unit outputs the image and sound data by using an isochronous transfer conformed to IEE1394-1995 standards ('922 - col. 12 lines 48-50.)

Regarding claim 4, Saito and Greening teach all the limitations of claim 4 (see the 103(a) rejection to claim 1 supra) including teaching an apparatus wherein the apparatus is a camera-integrated digital video recorder ('922 - col. 4 lines 37-44, in which the camera, indicator 4 of fig. 1, can be integrated with a DVD-R or DVD-RAM drive.)

Regarding claim 9, Saito and Greening teach all the limitations of claim 9 (see the 103(a) rejection to claim 1 supra) including teaching an apparatus further comprising an image data generating unit adapted to capture an image and generate the image data that is to be recorded on the recording medium ('922 - fig.1 indicator 4), and a sound data generating unit ('912 - 3 line 63 – col. 4 line 7) adapted to collect a sound and generate the sound data that is to be recorded on the recording medium.

Regarding claim 10, Saito and Greening teach all the limitations of claim 9 (see the 103(a) rejection to claim 2 supra) including teaching an apparatus further comprising an image data generating unit adapted to capture an image and generate the image data that is to be recorded on the recording medium ('922 - fig.1 indicator 4), and a sound data generating unit ('912 - 3 line 63 – col. 4 line 7) adapted to collect a sound and generate the sound data that is to be recorded on the recording medium.

Regarding claims 5-8, 11 and 12, although the wording is different, the material is considered substantively equivalent to claims 1- 4, 9 and 10, respectively, as discussed above.

**Contact**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Vieaux whose telephone number is 571-272-7318. The examiner can normally be reached on Monday - Friday, 8:00am - 4:00pm.

5 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, NgocYen T. Vu can be reached on 571-272-7320. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for  
10 published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Gcv2

  
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PRIMARY EXAMINER